

Application Serial No.: 09/783,410  
Amendment dated: December 19, 2003

Reply to Office action of: September 25, 2003  
Attorney Docket No.: ARC9200000105US1

### **REMARKS**

This Amendment is in response to the Office Action of September 25, 2003. Applicants respectfully submit that all the claims presently on file are in condition for allowance, which action is earnestly solicited.

### **THE CLAIMS**

#### **CLAIMS REJECTION UNDER 35 U.S.C. 102**

Claims 1-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Smith et al. (2002/0010625 A1). Applicants submit that Smith does not disclose all the elements and limitations of the claims presently on file. Consequently, these claims are not anticipated under 35 U.S.C. 102 and their allowance is earnestly solicited. In support of this position, Applicants submit the following arguments:

#### **A. Withdrawal of Smith as a Reference**

Applicants respectfully request the withdrawal of the Smith patent as a reference, in that the filing date of the present application, namely February 14, 2001, precedes the filing date of Smith, namely March 29, 2001.

The Smith patent was filed as a continuation-in-part of a parent application, which, in turn, was filed on September 18, 1998. If the Examiner wishes to use the parent application as a prior art reference, then the Examiner is requested to cite that parent application instead of the issued

Application Serial No.: 09/783,410  
Amendment dated: December 19, 2003

Reply to Office action of: September 25, 2003  
Attorney Docket No.: ARC9200000105US1

Smith patent, and submit a copy of that patent application for consideration by the Applicants. Furthermore, the Examiner is requested to make reference to the relevant texts in the parent application and not in the issue patent.

This request is based on the fact that since the Smith patent was filed as a continuation-in-part application, it is not clear to Applicants which subject matter disclosed in Smith retains the benefit of the priority date of 1998, and which subject matter was disclosed at a later date and thus does not retain the benefit of the priority date of 1998. Nonetheless, Applicants will submit herein arguments in support of distinguishing Smith over the instant claim 1 as amended.

**B. Legal Standard for Lack of Novelty (Anticipation)**

The standard for lack of novelty, that is for "anticipation," is one of strict identity. To anticipate a claim for a patent, a single prior source must contain all its essential elements, and the burden of proving such anticipation is on the party making such assertion of anticipation. Anticipation cannot be shown by combining more than one reference to show the elements of the claimed invention. The amount of newness and usefulness need only be minuscule to avoid a finding of lack of novelty.

The following are two court opinions in support of Applicant's position of non anticipation, with emphasis added for clarity purposes:

Application Serial No.: 09/783,410  
Amendment dated: December 19, 2003

Reply to Office action of: September 25, 2003  
Attorney Docket No.: ARC9200000105US1

- "Anticipation under Section 102 can be found only if a reference shows exactly what is claimed; where there are differences between the reference disclosures and the claim, a rejection must be based on obviousness under Section 103." *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985).
- "Absence from a cited reference of any element of a claim of a patent negates anticipation of that claim by the reference." *Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565, 230 USPQ 81 (Fed. Cir. 1986), on rehearing, 231 USPQ 160 (Fed. Cir. 1986).

**C. Application of the Legal Standards**

Applicants present the following arguments in response to the office action, in support of the allowance of the representative claim 1.

Application Serial No.: 09/783,410  
Amendment dated: December 19, 2003

Reply to Office action of: September 25, 2003  
Attorney Docket No.: ARC9200000105US1

<u>CLAIM 1</u>	<u>OFFICE ACTION (SMITH)</u>	<u>ARGUMENTS</u>
1. A method of providing a shopping proposal that enhances a merchant's <u>existing database system</u> , comprising:	Smith et al. discloses a system and method of providing a shopping proposal that enhances a merchant's existing database system and the computer program as claimed with the steps of:	(1) The method of Smith does not "enhance" the merchant's <u>existing</u> database system.
analyzing a catalog of items in the existing database system based on <u>a set of predefined rules that correlate the items under certain conditions</u> , to determine which of the items in the catalog are related to other items in the catalog, and to define a new set of relations between the catalog items;	analyzing a catalog of items in the existing database system based on a set of predefined rules (via online catalog of products see box [0047]), to determine which of the items in the catalog are related to other items in the catalog (via lists of related products on product detail pages), and to define a new set of relations between the catalog items (via storing in a table that maps items to sets of similar items).	(2) Smith's rules are distinctively different from the rules as defined in the present application.

Application Serial No.: 09/783,410  
Amendment dated: December 19, 2003

Reply to Office action of: September 25, 2003  
Attorney Docket No.: ARC9200000105US1

<u>wherein each rule comprises an evidence and a conclusion, and leads to new associations between the catalogue items;</u>		
applying the new set of relations to the existing database system to update the database system by providing the new associations of the items in the database system;	applying the new set of relations to the existing database system (via item relationships determined using a content-based analysis) to update the database system by providing new associations of the items in the database system (list of items that are "known" to be of interest to the user (box [0052], lines 9-27), and	(3) Smith does not describe generating a shopping advisor knowledge database that comprises the new associations for each item of the existing database system
<u>generating a shopping advisor knowledge database that comprises the new associations for each item of the existing database system; and</u>		

Application Serial No.: 09/783,410  
Amendment dated: December 19, 2003

Reply to Office action of: September 25, 2003  
Attorney Docket No.: ARC9200000105US1

offering automated, dynamic, and personalized shopping advice to the shopper based on a shopper query, <u>by retrieving the new associations in the shopping advisor knowledge database to items from the existing database system</u> that have been related by the new associations.	offering automated, dynamic, and personalized shopping advice to the shopper based on a shopper query (via generating recommendation that are specific to a particular shopping cart based solely ), by retrieving links to items from the database system that have been related by the new associations.	
--	--	--

Application Serial No.: 09/783,410  
Amendment dated: December 19, 2003

Reply to Office action of: September 25, 2003  
Attorney Docket No.: ARC9200000105US1

### C.1. First Distinguishable Element

The method of Smith does not "enhance" the merchant's existing database system. As illustrated in Fig. 1 of Smith and the related text, the Smith system uses one table 60 that qualifies as an existing database. However, Smith does not disclose an existing database with another enhancement database as recited in the instant claim 1.

### C.2. Second Distinguishable Element

Smith's "rules" are distinctively different from the rules as defined in the present application. As clearly recited in the amended claim 1 and in the present specification, each "rule" comprises an evidence and a conclusion, and leads to new associations between the catalogue items. On the other hand, the association, which is treated by the Examiner as a "rule," defines a simple hierarchy, as described in block [0047] of Smith. Contrary to the present invention, the hierarchy in Smith does not include an evidence and a conclusion.

### C.3. Third Distinguishable Element

Smith does not describe generating a shopping advisor knowledge database that comprises the new associations for each item of the existing database system.

Application Serial No.: 09/783,410  
Amendment dated: December 19, 2003

Reply to Office action of: September 25, 2003  
Attorney Docket No.: ARC9200000105US1

As presented earlier, the present invention does not describe a supplemental shopping advisor knowledge database that provides an automated, dynamic, and personalized shopping advice to the shopper based on the shopper query, by retrieving the new associations in the shopping advisor knowledge database to items from the existing database system.

As used herein, the term "advice" is based on the fact that all associations between items are created based on the ruleset. The ruleset is defined by one or more experts in a certain field, such as fashion or electronics, and will lead to associations that are reasonable and appropriate in terms of the respective field. As a result, every related item can be understood as an advice or a recommendation to combine the currently selected item with any one or more of the related items.

Consequently, independent claim 1 is not anticipated by Smith, and the allowance of claim 1 and the claims dependent thereon is respectfully requested.

**D. Independent Claims 9 and 17 and their Dependent Claims**

Applicants submit that the independent claims 9 and 17 are also allowable for reciting subject matter that is generally similar to claim 1. Consequently, independent claims 9 and 17 are not anticipated by Smith, and the allowance of these claims and the claims dependent thereon is respectfully requested.

Application Serial No.: 09/783,410  
Amendment dated: December 19, 2003

Reply to Office action of: September 25, 2003  
Attorney Docket No.: ARC9200000105US1

### TELEPHONE INTERVIEW

Applicants respectfully request a telephone interview to discuss claim 1 in view of Smith.

### CONCLUSION

All the claims presently on file in the present application are in condition for immediate allowance, and such action is respectfully requested. If it is felt for any reason that direct communication would serve to advance prosecution of this case to finality, the Examiner is invited to call the undersigned at the below-listed telephone number.

Respectfully submitted,



Date: December 19, 2003

Samuel A. Kassatly Law Office  
6819 Trinidad Drive  
San Jose, CA 95120  
Tel: (408) 323-5111  
Fax: (408) 323-5112

Samuel Kassatly  
Attorney for Applicants  
Reg. No. 32,247